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Dong-Youl Lee

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONG-YOUL LEE

Appeal 2009-004643
Application 09/805,929
Technology Center 2600

Decided: September 25, 2009

Before JOHN C. MARTIN, KARL D. EASTHOM, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ An oral hearing for this appeal was held on September 10, 2009.

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 16-28 and 30. *See* App. Br. 5 and Ans. 4.² We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

STATEMENT OF THE CASE

Appellant invented a device and method for placing a phone call from a mobile phone in a combined public and private common wireless cell area³

Claim 16 is illustrative of the invention and reads as follows:

16. A call originating service method in a public/private common mobile communication system, the method comprising :

providing the public/private common mobile communication system comprising a plurality of mobile stations (MSs), a mobile switching center (MSC), a plurality of public mobile communication network base station controllers (BSCs) connected to the MSC, a plurality of public mobile communication network base station transceiver subsystems (BTSs) connected to each of the plurality of BSCs, each of the plurality of these BTSs adapted to form a corresponding public-only cell area, a public/private communication service unit connected to one of the public mobile communication network's BSCs, and a private BTS connected to the public/private communication service unit, the private BTS adapted to form a public/private common cell area, one of said plurality of MSs being within said public/private common cell area;

² Appellant filed an Appeal Brief on June 17, 2008. A "Notification of Non-Compliant Appeal Brief" was mailed June 30, 2008. Appellant filed a Corrected Appeal Brief on July 8, 2008. We will refer to the Appeal Brief filed on July 8, 2008.

³ *See generally* App. Br. 7-16.

receiving at the public/private communication service unit a call origination message from the MS in the public/private common cell area through the private BTS;

determining whether the MS in the public/private common cell area is registered for a private mobile communication service by analyzing the received call origination message;

transmitting transparently the call origination message to one of said plurality of public mobile communication network BSCs when the MS in the public/private common cell area is not registered for the private mobile communication service, and determining whether identification information for the private mobile communication service is included in the call origination message when the MS in the public/private common cell area is registered for the private mobile communication service; and

transmitting transparently the call origination message to one of said plurality of public mobile communication networks BSCs when the identification information is not included in the call origination message, and providing private mobile communication service for the MS in the public/private common cell area when the identification information is included in the call origination message.

The References and Rejections

The Examiner relies upon the following prior art reference as evidence of unpatentability:

Mauger	US 5,537,610	Jul. 16, 1996
Fujii	US 5,818,918	Oct. 6, 1998
Widergen	US 5,890,064	Mar. 30, 1999
Lu	US 5,999,813	Dec. 7, 1999

- A. Claims 16-18, 25, 26, 28 and 30 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Widergen and Mauger (Ans. 5-15).
- B. Claims 19 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Widergen and Fujii (Ans. 16-18).
- C. Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Widergen, Mauger and Fujii (Ans. 18-20).
- D. Claims 22 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Widergen, Mauger and Lu (Ans. 20-22).
- E. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Widergen, Fujii and Lu (Ans. 22-23).

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Appellant's Independent Claims 16-19

Appellant argues independent claims 16, 17, 18 and 19 as a group and fails to address the rejections under a separate heading in accordance with 37 C.F.R. § 41.37(c)(1)(vii) (2008). The Appellant argues that in each of the independent claims 16-19, the *Appellant claims transmitting transparently a call origination message to a base station controller (BSC) in a public mobile communication network* (App. Br. 18). It is the Examiner's position

that the Appellant is arguing features (*call origination message is the packet*) that are not recited in the claims (Ans. 23-24).

ISSUE

Has Appellant shown that the Examiner erred in finding that Widergen discloses transparently transmitting a call origination message to a base station in a public mobile communication network?

FINDINGS OF FACT

1. Figure 7 of Appellant's disclosure is reproduced below:

DEST ADDR(4 BYTES)		
SRC ADDR(4 BYTES)		
TYPE(1 BYTE)	LENGTH(1 BYTE)	SIG ID(2 BYTES)
DEST SUB ID(2 BYTES)		SRC SUB ID(2 BYTES)
MSG		

Figure 7 illustrates a call origination message having a packet message format (Spec. ¶ [0034]).

2. Figure 1 of Widergen is reproduced below:

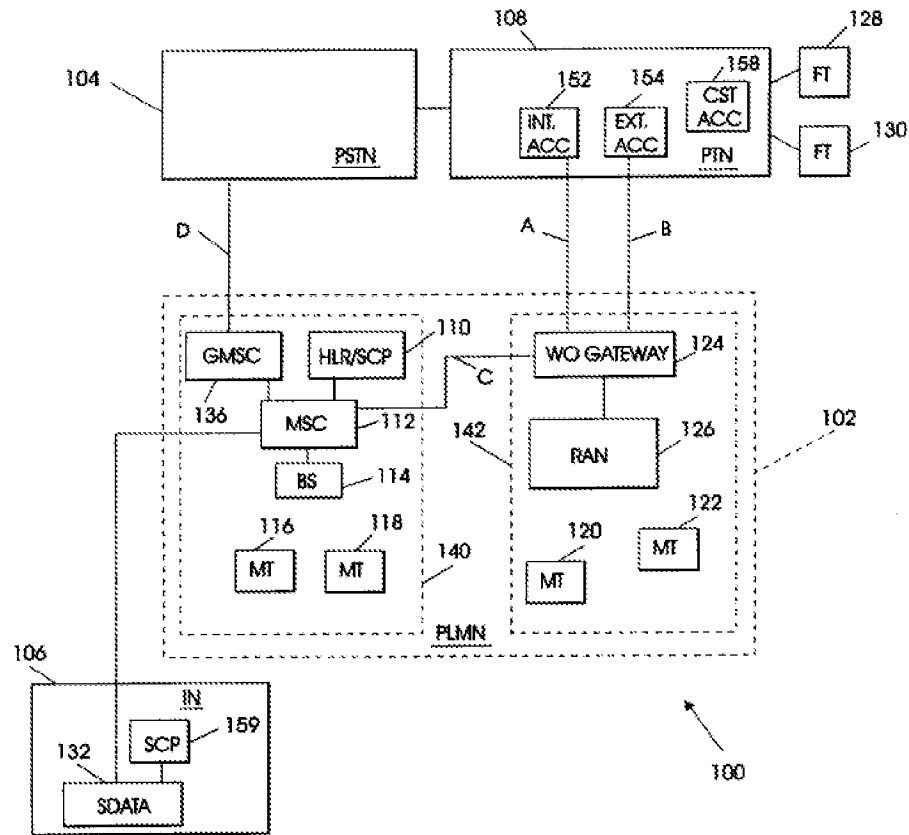


Figure 1 is a schematic block diagram of a public telecommunication network wherein a wireless office system is integrated into both a private telephony network and a public land network that includes a public cellular system (Widergren, col. 2, ll. 18-21).

3. Widergren discloses in call scenario case 5 that because the caller is a CMT, the call is unconditionally routed to PTN 108. The dialed number is also transparently sent to PTN 108 on the signaling link (col. 9, ll. 48-50).

4. Appellant's disclosure (Spec. ¶ [0029]) provides that both the public mobile communication service and the private mobile communication service is performed by analyzing every message being applied to the public/private communication service unit 12, transparently transmitting the messages for the public mobile communication network to the public BSC,

and routing the messages for the private mobile communication network to a module in the call manager 50.

PRINCIPLES OF LAW

Although giving claims their broadest reasonable interpretation must take into account any definitions given in the specification, *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), it is improper to read into the claims limitations from examples given in the specification. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). See also *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (“[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments . . . In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment”) (citations omitted).

“Unsubstantiated attorney argument regarding the meaning of technical evidence is no substitute for competent, substantiated expert testimony.” *Invitrogen Corp. v. Clontech Laboratories, Inc.*, 429 F.3d 1052, 1068 (Fed. Cir. 2005).

“The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art.” *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *Keller*, 642 F.2d at 425). In determining

obviousness, furthermore, a reference “must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” *Id.*

ANALYSIS

Call Origination Message

The Appellant argues that *although Widergen does discuss transparent transmission of a dialed number*, Widergen does not disclose the transparent transmission of a call origination message (App. Br. 18). The Examiner indicates that Widergen discloses call setup messages from the mobile station 122 through the private BTS 126 in the public/private common cell area 142 to the public/private communication service unit 124 (Ans. 6). *Also see* FF 2. The Examiner further indicates that the call origination message limitation reads upon Widergen’s call setup message (Ans. 6) and explains that the call setup message includes the dialed party’s number, which may be accompanied by two additional digits when the call is to a public number (Ans. 25). The Examiner further found that although Widergen discloses transparently transmitting the call setup message to PTN (*private* telephony network) 108 (Ans. 8), Widergen fails to disclose transparently transmitting a call setup message to a *public* network BSC, for which teaching the Examiner relies on Mauger (Ans. 8).

Appellant argues that a call origination message is not a dialed number because a call origination message contains a source address, a message, a type byte, a length byte, source and destination processor IDs in addition to a destination address (App. Br. 21). *Also see* FF 1. The Appellant argues that FIG. 7 defines the structure of the call origination message as containing a variety of elements that distinguishes it from a

dialed number (App. Br. 21). However, FIG. 7 is a non-limiting example of a call orientation message. See *Phillips*, 415 F.3d at 1323. Appellant states that the definition of the call origination message can be found in his specification in paragraphs [0033] and [0034] (Reply Br. 3). However, the specification states that “[t]he call origination message transmitted from pBTS 8_k to the public/private communication service unit 12 has the packet message format shown in FIG. 7” (§ [0033]) (emphasis added). Again, the Appellant’s specification only discloses an embodiment of a call origination message while failing to provide a definition for the message. See §§ [0033], [0034] and FF 1.

The Appellant emphasizes that his Specification along with FIG. 7 has made it clear that a call origination message is not a dialed number (App. Br. 21). However, Appellant’s Specification does not provide a definition of the term “call origination message” and Appellant has not explained why the claim language, when given its broadest reasonable interpretation consistent with Appellant’s disclosure, precludes Widergen’s dialed number from being considered to be a call origination message.

Therefore the claim language employed in the independent claims 16, 17, 18 and 19 does not preclude the call origination message limitations from reading upon Widergen’s dialed number.

Transparent Transmission

The Appellant admits that Widergen discloses the transparent transmission of a dialed number. See App. Br. 18. Appellant states, “*Because Widergen only teaches transparent transmission of a dialed number and not a call origination message, and because a call origination*

message is something entirely different from a dialed number, Appellant submits that the Examiner's primary argument that Widergen teaches transparent transmission of a call origination message is without merit" (emphasis added). (App. Br. 18-19). *Also see* FF 3. We have determined that the call origination message limitations in claims 16, 17, 18 and 19 are not distinguishable over Widergen's dialed number for reasons indicated previously. Therefore it follows that Widergen discloses the transparent transmission of a call origination message by disclosing the transparent transmission of a dialed number.

The Appellant, apparently addressing the requirement of claim 16 for transmitting transparently the call origination message to a *public* mobile communication network BSC, further argues that Widergen discloses a call origination message that is permanently changed. *See* App. Br. 19. In view of Appellant's explanation in the Reply Brief (at 4) that the arguments regarding the "transparently transmitting" limitation should not be construed as admitting that Widergen discloses the claimed "call origination message," we are treating the phrase "call origination message" in those arguments as referring to what the Examiner considers to be the call origination message in Widergren.

Appellant argues that column 5, lines 49-53 and column 9, line 39 to column 10, line 1 of Widergen show that the call origination message is changed when a call is made to a phone in a public network and therefore the transparently transmitted call origination message specified in Widergen's call scenario case 5 is not transparently transmitted to a public mobile communication network BSC. *See* App. Br. 19. *Also see* FF 3. Appellant has not set forth a persuasive argument or presented compelling

evidence that supports his position that Widergren's call origination message is not transparently transmitted. The Appellant's Specification does not describe when the transmission of a call origination message is considered to be transparent. *See* FF 4. Appellant's specification does not provide a definition of the term "transparent" in regards to the call origination message. The definition of "transparent transmission" provided at page 2, footnote 1, of the Reply Brief and allegedly based on definitions provided in a January 30, 2007, Amendment is belatedly presented and therefore entitled to no consideration. *See Optivus Tech., Inc. v. Ion Beam Appls. S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (argument raised for the first time in the reply brief that could have been raised in the opening brief is waived); *accord, Ex parte Scholl*, No. 2007-3653, slip op. at 18 n.13 (BPAI March 13, 2008) (designated as "Informative Opinion"), *available at* <http://www.uspto.gov/web/offices/dcom/bpai/its/fd073653.pdf>.

Furthermore, Appellant has not explained why the Examiner erred in relying on Mauger for a teaching of modifying Widergren so as to provide transparent transmission of Widergren's call origination message to a public mobile communication network BSC. At page 25 of the Appeal Brief, Appellant merely asserts that "Mauger, like Widergren, fails to teach a transparent transmission of a call origination message to a public network as claimed by Appellant."

Secondary Concerns

The Appellant characterizes some of the Examiner's positions as *secondary concerns* (App. Br. 20-27). The *secondary concerns* pertain to subject matter that we have addressed previously or bear no relevance to the obviousness rejections. Within the *secondary concerns*, the Appellant

addresses the Mauger and Fujii references separate from Widergen reference. *See* App. Br. 25-26. “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). However, in the Reply Brief, the Appellant attempts to address the obviousness rejections by addressing the rejections based upon the combination of the references for the first time (Reply Br. 5-10). Appellant’s assertion that he is replying to the Examiner comments in the Answer is not persuasive. *See* Reply Br. 5. These arguments were not timely raised in the Appeal Brief, but rather were raised for the first time in the Reply Brief. As such, these arguments are waived⁴.

We will sustain the Examiner’s obviousness rejections of claims 16-18 over Widergen and Mauger (Ans. 5-15). We will also sustain the Examiner’s obviousness rejection of claim 19 over Widergen and Fujii (Ans. 16-18). Appellant states, “All remaining pending claims 16-28 and 30 are on appeal.” (App. Br. 5), but fail to argue the merits of the rejection of claims 20-28 and 30. Since the Appellant has not presented arguments rebutting the Examiner’s prima facie case of obviousness for these claims, we will sustain the Examiner’s rejection of claims 20-28 and 30. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

CONCLUSION

Appellant has not shown that the Examiner erred in finding that Widergen and Mauger collectively teach transparently transmitting a call

⁴ *See Optivus*, 469 F.3d at 989 (“[A]n issue not raised by an appellant in its opening brief . . . is waived.”) (citations and quotation marks omitted).

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origination message to a base station in a public mobile communication network.

ORDER

We will sustain the Examiner's decision rejecting claims 16-28 and 30.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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